

REMARKS

1. Summary of Rejections

In the Office Action mailed March 26, 2004, the Examiner rejected claims 1-3, 7, 11-13, 15, and 21-22 under 35 U.S.C. § 102(b) as being anticipated by Nakamura, U.S. Patent No. 5,943,617 ("Nakamura"). The Examiner rejected claims 6, 8-10, 14, and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura, in view of Ortiz Perez et al., U.S. Patent No. 5,469,494 ("Ortiz Perez"). The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura, in view of Anderson, U.S. Patent No. 6,199,032 ("Anderson"). The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura, in view of Selig et al., U.S. Patent No. 5,764,726 ("Selig").

Applicants herein have canceled claim 13, added new claim 23, and amended claims 14-22. Thus, claims 1-12 and 14-23 are currently pending.

For the following reasons, Applicants respectfully request reconsideration and allowance of the claims, as amended.

2. Response to Rejections

a. **Claims 1-11**

Of these claims, claim 1 is independent. The Examiner has rejected claim 1 as being anticipated by Nakamura. However, the Examiner's rejection of claim 1 is flawed for at the least the following reasons.

Claim 1 recites four steps that make use of a “test host.” However, the Examiner has not established that Nakamura discloses a “test host” that is involved in all four steps recited in claim 1. Instead, the Examiner appears to identify “testing device 15” in Nakamura as the “test host” in steps (a) and (d) but then, inconsistently, appears to identify “test terminal 11” in Nakamura as the “test host” in steps (b) and (c). For example, the Examiner has alleged that step (c), which recites “the test host performing a comparison between the first test signal and the second test signal,” is disclosed in Nakamura at col. 6, lines 1-12. That section states that “[i]n the test terminal 11, the CPU 27 compares the second test pattern in the test pattern memory 24 with the received pattern in the image data memory 25.” Thus, the Examiner’s rationale with respect to step (c) is premised on “test terminal 11” being the test host. However, the Examiner has alleged that step (d), which recites “the test host providing an output indicative of a result of the comparison,” is disclosed in Nakamura at col. 6, lines 13-22. That section states that “[i]n the testing device 15, the down-link test data are notified to an operator of the testing device, by for example, a display and/or a printer.” Thus, the Examiner’s rationale with respect to step (d) is premised on “testing device 15” being the test host.

The Examiner’s rationale also fails to clearly identify what the Examiner considers to be the “first communication device” and the “second communication device” in Nakamura. For example, with respect to step (a), which recites “using a test host to cause a first communication device to send a first test signal into a communications channel,” the Examiner refers to testing device 15 in Figure 2 and col. 4, lines 55-65 in Nakamura. How does that disclosure show a “test host” *and* a “first communication

device,” as recited in claim 1? With respect to step (b), which recites “receiving a second test signal in the test host from the communications channel via a second communication device,” the Examiner refers to test terminal 11 in Figure 2 and col. 4, line 66 – col. 5, line 9 in Nakamura. How does that disclosure show a “test host” **and** a “second communication device,” as recited in claim 1?

Thus, the Examiner’s rationale for rejecting claim 1 is flawed because the Examiner has not established that Nakamura discloses a “test host” that is involved in the four steps recited in claim 1. In fact, Nakamura teaches away from using a “test host” as recited in claim 1 in that Nakamura teaches a radio channel testing system that comprises a testing device 15 **and** a plurality of test terminals 11. (col. 4, lines 26-30). Accordingly, Applicants respectfully submit that claim 1 is allowable over Nakamura and the other prior art of record. Applicants further submit that claims 2-11 are also allowable for at least the reason that they are dependent upon an allowable claim.

b. Claim 12

The Examiner has rejected claim 12 as being anticipated by Nakamura. However, the Examiner’s rationale does not address the elements that are actually recited in claim 12. In particular, claim 12 recites the use of first and second non-simulated wireless subscriber terminals, whereas the Examiner’s rationale instead refers to first and second communication devices. In addition, claim 12 recites a first set of data and a second set of data, whereas the Examiner’s rationale instead refers to a first test signal and a second test signal.

The Examiner has not established that Nakamura discloses the use of a “test host” as recited in claim 12. Accordingly, Applicants respectfully submit that claim 12 is patentable over Nakamura and the other prior art of record for at least the reasons described above for claim 1.

c. Claims 14-23

The Examiner rejected claim 13 as being anticipated by Nakamura. In response, Applicants have canceled claim 13, added new independent claim 23, and amended claims 14-22 so that they are now dependent on claim 23.

New claim 23 recites a first communication device, a second communication device, and a test host communicatively coupled to the first and second communication devices. The test host includes (a) a sending component that causes the first communication device to send the first test signal into the network; (b) a receiving component that receives the second test signal from the second communication device; (c) a comparing component that makes a comparison of the first test signal to the second test signal; and (d) a display that indicates the result the comparison. Thus, Applicants respectfully submit that new claim 23 is allowable over Nakamura and the other prior art of record for at least the reasons described above for claim 1. Applicants further submit that claims 14-22 are also allowable for at least the reason that they are dependent upon an allowable claim.

3. **Conclusion**

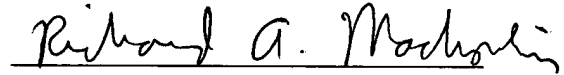
Applicants submit that the present application is now in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, he is invited to telephone the undersigned at any time at (312) 913-0001.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Dated: June 15, 2004

By:



Richard A. Machonkin

Reg. No. 41,962